REMARKS

The non-final Office Action mailed October 5, 2009 has been received and reviewed. Prior to the present communication, claims 10-11, 15, 17-18, 20-22, 24-28, and 30-31 were pending in the subject application. All of claims 10-11, 15, 17-18, 20-22, 24-28, and 30-31 have been amended and claims 32-36 have been added. Care has been exercised to introduce no new matter.

Claims 10-11, 15, 17-18, 20-22, 24-28, and 30-36 are pending and are believed to be in condition for allowance. Applicants respectfully request reconsideration of the present application in view of the above amendments and the above amendments and the following remarks.

Amendments to the Specification

Amendments to the specification have been made as hereinabove set forth in order to correct minor errors and provide consistency between Applicants' original specification and drawings. No new matter has been introduced as a result of said amendments. Applicants respectfully request entry of said amendments to the specification.

Rejections based on 35 U.S.C. § 103(a)

A) Applicable Authority

Title 35 U.S.C. § 103(a) declares, a patent shall not issue when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The Supreme Court in *Graham v. John Deere* counseled that an obviousness determination is made by identifying: the scope and content of the prior art; the level of ordinary skill in the prior art; the differences between the

claimed invention and prior art references; and secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1 (1966). To support a finding of obviousness, the initial burden is on the Office to apply the framework outlined in *Graham* and to provide some reason, or suggestions or motivations found either in the prior art references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the prior art reference or to combine prior art reference teachings to produce the claimed invention. See *Application of Bergel,* 292 F.2d 955, 956-957 (CCPA 1961).

B) Obviousness Rejection Based on U.S. Pub. No. 2004/0119762 (hereinafter "Denoue"), U.S. Pat. No. 7,042,594 (hereinafter "Dawe"), and U.S. Pub. No. 2008/0046837 (hereinafter "Beauchamp")

Claims 10, 20-22 and 30 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Denoue in view of Dawe, and further in view of Beauchamp. Applicants respectfully traverse and request withdrawal of said rejection for the following reasons.

Independent claim 10 has been amended to require, in part, "receiving an annotation drawn by the user on the display, wherein the received annotation is implemented using a plurality of tools via a toolbar, the toolbar appearing after the selecting an on-screen region." The Office acknowledged that neither Benoue nor Dawe describe annotating graphical elements in response to the user command, and then cited Beauchamp as describing this claimed feature (*see OA*, p.4). Beauchamp describes a transparent pen-enabled window over a non-pen-enabled window for purposes of annotation (*see Beauchamp,* Abstract). However, Beauchamp is silent as to implementing received annotations via a toolbar, as claimed by Applicants' amended independent claim 10.

As Benoue in view of Dawe and Beauchamp fails to describe each and every element as set forth in independent claim 10, as amended herein, it is respectfully submitted that the prior art of record fails to render this claim obvious. Similarly, the prior art of record fails to render obvious dependent claims 20-22 and 30 for at least the reasons discussed above with regard to amended independent claim 10. Each of claims 10, 20-22, and 30 is believed to be in condition for allowance and such favorable action is requested.

C) Obviousness Rejection Based on U.S. Pub. No. 2004/0119762 (hereinafter "Denoue"), U.S. Pat. No. 7,042,594 (hereinafter "Dawe"), U.S. Pub. No. 2008/0046837 (hereinafter "Beauchamp"), and U.S. Pat. No. 6,334,157 (hereinafter "Oppermann")

Claims 11 and 25-26 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Denoue in view of Dawe and Beauchamp, and further in view of Oppermann. Applicants respectfully traverse and request withdrawal of said rejection for the following reasons.

Claims 11 and 25-26 depend from amended independent claim 10. As discussed above, amended independent claim 10 is believed to be allowable over the prior art of Denoue, Dawe, and Beauchamp. Oppermann is directed to accessing and manipulating user interface elements of an application program (*see Oppermann*, Abstract), and does not compensate for the deficiencies of Denoue, Dawe, and Beauchamp. Therefore, claims 11 and 25-26 are also believed to be allowable over the prior art of record, at least for the reasons pertaining to amended independent claim 10.

D) Obviousness Rejection Based on U.S. Pub. No. 2004/0119762 (hereinafter "Denoue"), U.S. Pat. No. 7,042,594 (hereinafter "Dawe"), U.S. Pub. No. 2008/0046837 (hereinafter "Beauchamp"), and U.S. Pub. No. 2004/0135815 (hereinafter "Browne")

Claims 15 and 18 have eben rejected under 35 U.S.C. § 103(a) as being unpatentable over Denoue in view of Dawe and Beauchamp, and further in view of Browne. Applicants respectfully traverse and request withdrawal of said rejection for the following reasons.

Claims 15 and 18 depend from amended independent claim 10. As discussed above, amended independent claim 10 is believed to be allowable over the prior art of Denoue, Dawe, and Beauchamp. Browne is directed to a graphical user interface for classifying and searching on a plurality of digital images. Metadata is associated with the digital images by selecting iconic or thumbnail representations of the images and dragging to a destination point in order to create an association with the images (*see Browne*, Abstract). Browne does not compensate for the deficiencies of Denoue, Dawe, and Beauchamp, and therefore, claims 15 and 18 are also believed to be allowable over the prior art of record, at least for the reasons pertaining to amended independent claim 10.

E) Obviousness Rejection Based on U.S. Pub. No. 2004/0119762 (hereinafter "Denoue"), U.S. Pat. No. 7,042,594 (hereinafter "Dawe"), U.S. Pub. No. 2008/0046837 (hereinafter "Beauchamp"), U.S. Pub. No. 2004/0135815 (hereinafter "Browne"), and U.S. Pub. No. 2003/0101156 (hereinafter "Newman")

Claim 17 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Denoue in view of Dawe, Beauchamp, and Browne, and further in view of Newman. Applicants respectfully traverse and request withdrawal of said rejection for the following reasons.

Claim 17 depends from amended independent claim 10. As discussed above, amended independent claim 10 is believed to be allowable over the prior art of Denoue, Dawe, and Beauchamp. Browne is directed to a graphical user interface for classifying and searching on a plurality of digital images. Metadata is associated with the digital images by selecting iconic or thumbnail representations of the images and dragging to a destination point in order to create an association with the images (*see Browne*, Abstract). In addition, Newman is directed to database systems and methods (*see Newman*, Abstract). Neither Browne nor Newman compensate for the deficiencies of Denoue, Dawe, and Beauchamp. Therefore, claim 17 is also believed to be allowable over the prior art of record, at least for the reasons discussed above with regard to amended independent claim 10.

F) Obviousness Rejection Based on U.S. Pub. No. 2004/0119762 (hereinafter "Denoue"), U.S. Pat. No. 7,042,594 (hereinafter "Dawe"), U.S. Pub. No. 2002/0076109 (hereinafter "Hertzfeld"), and U.S. Pat. No. 6,334,157 (hereinafter "Oppermann")

Claims 24 and 27 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Denoue in view of Dawe, Hertzfeld and Oppermann. Applicants respectfully traverse and request withdrawal of said rejection for the following reasons.

Independent claim 27 has been amended to require, in part, "in response to automatically determining that displayed content of the on-screen region includes the textual data, automatically extracting a character or word from the textual data and extracting complete sentences based upon punctuation as context information." The Office acknowledged that Denoue does not describe the claimed feature of, determining that the displayed content of the on-screen region includes textual data and extracting the character or word, and then cited Dawe as describing this feature (*see OA*, p.12). However, Dawe is silent as to extracting complete

sentences, and in particular, extracting complete sentences based upon punctuation. Hertzfeld is directed to a context sensitive recognition method for interpreting text (*see Hertzfeld*, Abstract), but is silent as to extracting complete sentences based upon punctuation, as claimed by Applicants' amended independent claim 27. Oppermann is directed to accessing and manipulating user interface elements of an application program (*see Oppermann*, Abstract), and does not compensate for the deficiencies of Denoue, Dawe, and Hertzfeld. Therefore, amended independent claim 27 and dependent claim 24 are believed to be allowable over the prior art of record.

G) Obviousness Rejection Based on U.S. Pat. No. 7,042,594 (hereinafter "Dawe"), U.S. Pub. No. 2008/0046837 (hereinafter "Beauchamp"), and U.S. Pub. No. 2004/0119762 (hereinafter "Denoue")

Claims 28 and 31 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Dawe in view of Beauchamp, and further in view of Denoue. Applicants respectfully traverse and request withdrawal of said rejection for the following reasons.

Independent claim 28 has been amended to require, in part, "a bounded character or word from textual data determined to be included in the on-screen region, and determining if the bounded character or word lies within the selected on-screen region." The Office cited Dawe as describing the claimed feature of, automatically extracting a character or word from the textual data (*see OA*, p.17). However, Dawe is silent as to determining if the bounded character or word lies within the selected on-screen region, as claimed by Applicants' amended independent claim 28. Beauchamp describes a transparent pen-enabled window placed over a non-pen-enabled window for purposes of annotation (*see Beauchamp,* Abstract), while Denoue is directed to freeform pasting (*see Denoue*, Abstract). Neither Beauchamp nor Denoue

compensate for the deficiencies of Dawe in describing Applicants' amended independent claim 28. Therefore, amended independent claim 28 and dependent claim 31 are believed to be allowable over the prior art of record.

NEW CLAIMS

Newly added claims 32-37 depend from amended independent claim 10, which was previously shown to be allowable over the prior art of record, thereby placing dependent claims 32-37 also in allowable condition, at least for the reasons discussed above with regard to amended independent claim 10.

CONCLUSION

For at least the reasons stated above, claims 10-11, 15, 17-18, 20-22, 24-28, and 30-36 are now believed to be in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of the claims. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned – 202/783-8400 or nberezny@shb.com (such communication via email is herein expressly granted) – to resolve the same.

The fee for a two-month extension of time is submitted herewith. It is believed that no additional fee is due. However, if this belief is in error, the Commissioner is hereby authorized to charge any additional amount required, or credit any overpayment, to Deposit Account No. 19-2112 with reference to Attorney Docket Number 306171.01/MFCP.153380.

Respectfully submitted,

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